

Appl. No. 10/769,344
Atty. Docket No. 9005MR
Amdt. dated 07/23/2007
Reply to Office Action of 03/22/2007
Customer No. 27752

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REMARKS

Claims 1-20 have been rejected and remain pending in the present application. Claims 1, 14 and 15 have been amended incorporating original claims 4, 11 and 17 into the claim language. Accordingly, claims 4, 11 and 17 have been canceled. No new matter has been added.

ART REJECTIONS

REJECTIONS UNDER 35 USC §103

Claims have been rejected under 35 USC §103(a) as being unpatentable over Wilson, USP 3,981,838 (hereinafter "Wilson") in view of Westbrook et al, USP 5,389,711 (hereinafter "Westbrook"). The Office states that Wilson shows ester compounds that read on applicants claimed solvent compound. The Office, however, concedes that the patent fails to specifically identify the claimed thermoplastic elastomer and oil and concludes that one of ordinary skill would find the block polymer species obvious from this disclosure given the knowledge generally available in the art and the understanding of how the plasticizers and lubricants function in thermoplastic elastomers. The Office continues with Westbrook stating that it has been applied to further show the art recognized the conventional use of aromatic ester compounds as plasticizers in thermoplastic elastomer compositions. Applicants respectfully traverse this rejection.

Wilson relates to the use of trimellitic acid di- and tri- diesters, di-ester salts and a mixture of oligomers as both internal and external lubricants in processing polyvinyl chloride. As admitted by the Office, Wilson fails to teach or suggest the use of Applicants' thermoplastic elastomer and oil. The Office believes it to be obvious to make such combination but fails to show how Wilson implies the elements of Applicants' invention. Applicants respectfully submit that the Office has invoked an improper hindsight response rather than a proper obviousness rejection. In determining obviousness, [t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and the obviousness of making the combination. *Lindeman Maschinenfabrick GmbH v.*

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American Hoist & Derrick Co., 730 F.2d 1452, 1462 (Fed. Cir. 1984); *Maize*, 5 USPQ 1788, 1793 (Fed. Cir. 1988). The Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See, *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). The test of whether a particular compound described in the prior art may be relied upon to show that claimed subject matter would have been obvious is whether the prior art provides an enabling disclosure with respect to the disclosed prior art compound. *Ashland Oil Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). It is not enough to simply state that general knowledge of plasticizers and lubricants would lead an ordinary skilled person to Applicants' presently claimed invention as amended. Particularly, it is not obvious to determine Applicants' selected oils at the specified glass transition temperatures.

Additionally, Westbrook fails to alleviate Wilson's shortcoming. Specifically, Westbrook teaches the use of "ionomers" or functionalized monovinyl aromatic polymers in which salt functional groups are incorporated "...into the polystyrene blocks to increase the polymer's solvent resistance, high temperature properties and tensile strength." See col. 1, lines 50-64. Westbrook then indicates that "[t]he same polymer without functionality is limited to service temperatures of about 100 °C." See *id.*, lines 62-64. Yet, the presently claimed copolymers are not "functionalized", i.e., they do not comprise salt functional groups, and contrary to Westbrook's teaching, they do not have the identified temperature limitations as is evidenced by the claimed phase change temperature range of from about 40°C to about 250°C. Moreover, ionomers as a class require an extremely polar additive such as water to dissociate the ionic groups and lower viscosity. See col. 1, through col. 2. Conversely, non-functionalized block copolymers such as those currently claimed are not plasticized by extremely polar compounds such as water and water may actually act as a non-solvent. Thus, Westbrook does not indeed teach or suggest the claimed polymers and actually teaches away from using the presently claimed polymers which are not functionalized as mandated by Westbrook. Applicants respectfully submit that it is error to find an invention obvious where prior art references diverges from the invention at hand. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983).

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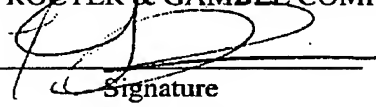
Based upon the foregoing, Applicants submit that Wilson in view of Westbrook does not render the pending claims obvious. As such, withdrawal of the § 103(a) rejections of claims 1-20 is respectfully requested.

CONCLUSION

In view of the above, Applicants respectfully submit that each of the issues raised by the Office Action has been addressed. Reconsideration and allowance of each of the pending claims is respectfully requested.

Respectfully Submitted,
THE PROCTER & GAMBLE COMPANY

By _____



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